APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,501	03/10/2006	Klaus Hoffmann	0119010-00143	4212

29177   7590   07/25/2008
BELL, BOYD & LLOYD, LLP
P.O. BOX 1135
CHICAGO, IL 60690

EXAMINER
PHUNG, LUAT

ART UNIT	PAPER NUMBER
2616	

MAIL DATE	DELIVERY MODE
07/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>*10 March 2006*</u>.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
  closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>*11-27*</u> is/are pending in the application.
  4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>*11-14,19-21 and 25*</u> is/are rejected.
7) ☒ Claim(s) <u>*15-18,22-24,26-27*</u> is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on <u>*10 March 2006*</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  a) ☒ All b) ☐ Some * c) ☐ None of:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. _____.
    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
  Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   Claims 15, 19 and 22-24 are objected to because of the following informalities:

Claim 15, line 6, recites "recvonly". It is suggested to change to --a=recvonly--.

The same problem exists in claim 20, lines 3 and 5 and claim 26, line 6.

Claim 19, line 9, recites "the status is disconnected" while reciting "the status is

active or inactive" in line 7. Is "disconnected" another possible value for "status"?

Claim 22, line 2, it is suggest to change "an deactivate ..." to --a deactivate...--.

The same problem exists in claim 23, line 2.

Claim 23, line 3, it is suggest to change "... include and activate attribute" to --...

include an activate attribute--.

Claim 23, line 3, recites "does include an[d] activate attribute." It appears to

intend to recite "does NOT include ..."; if so, it is suggested to add the missing word –

not--.

Claim 24, line 3, it is suggest to change "... include a activate attribute" to --...

include an activate attribute--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

3.   Claims 13-18 and 25-27 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

Claim 13 recites the limitation "the subscriber" in line 2. There is insufficient

antecedent basis for this limitation in the claim. It is unclear whether it refers to "a third

subscriber" as recited in this claim, or "a first subscriber" or "a second subscriber" as

recited in claim 11 from which claim 13 depends on.

Claims 14-18 are rejected as being dependent upon a rejected base claim,

namely claim 13.

Claim 25 recites the limitation "the second message" in the last line. There is

insufficient antecedent basis for this limitation in the claim.

Claims 26-27 are rejected as being dependent upon a rejected base claim,

namely claim 25.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention
> was made.

5.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

6.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

     1.   Determining the scope and contents of the prior art.
     2.   Ascertaining the differences between the prior art and the claims at issue.
     3.   Resolving the level of ordinary skill in the pertinent art.
     4.   Considering objective evidence present in the application indicating
             obviousness or nonobviousness.

7.   Claims 11-14 and 25 are rejected under U.S.C. 103(a) as being unpatentable

over ITU-T Q.734 (Stage 3 Description for Multiparty Supplementary Services Using

SS7, 03/93, hereinafter Q.734), in view of Sinnreich, et al ("Internet Communications

Using SIP", October 2001, John Wiley & Sons).

     Regarding claim 11, Q.734 discloses a method for interworking protocols to

provide a performance feature in a communication network, comprising:

     providing a first protocol that controls a first subscriber; (messages to/from user B

per Fig. 2-1)

     providing a second protocol that controls a second subscriber; (messages

to/from user C per Fig. 2-1)

disconnecting an established data channel between the first subscriber and the

second subscriber (user A creating private conversation with one of remote parties

during three-way conversation, i.e., disconnecting established data channel between

remote users B and C, per sec. 2.2.1, resulting in call A-B on hold and A-C active per

Fig. 2-1)

receiving a notification of a call progress for the performance feature in

accordance to the first protocol; (user B receiving notification of three-party service call

per Fig. 2-1) and

interworking the notification into the second protocol. (user A communicating

using messages to user B and C)

Q.734 does not explicitly disclose disconnecting by deactivating a transmitter for

the second subscriber. However, Q.734 discloses placing the creating a private

conversation (call A-C active, by placing call A-B on hold per Fig. 2-1). Sinnreich from

the same or similar fields of endeavor discloses placing a call on hold by causing the

recipient to stop sending media packets (page 139, para. Call Hold). Thus it would

have been obvious to the person of ordinary skill in the art at the time of the invention to

place the call on hold as per Q.734 by deactivating a transmitter for the second

subscriber, i.e., instructing held party to stop sending media packets as suggested by

Sinnreich. The motivation for doing so would have been to avoid sending data that will

not be used when the call is on hold.

Regarding claim 12, Q.734 further discloses

wherein the performance feature is a large conference feature in accordance to the International Telecommunications Union (ITU) standard Q.734.1 (conference calling per sec. 1) or a small conference feature in accordance to the ITU standard Q.734.2 (three party per sec. 2), and

wherein the disconnect according to the first protocol is produced by interrupting the established data channel in a central transmission mode. (disconnect by interrupting established conference call by user A as an intermediate between users B and C per Fig. 2-1)

Regarding claim 13, Q.734 further discloses wherein the deactivation occurs when a third subscriber is added to the conference or the subscriber is isolated from the conference. (user A creating private conversation, e.g., isolating user B during three-way conversation per sec. 2.2.1)

Regarding claim 14, Q.734 further discloses wherein interworking occurs when the transmitter is deactivated. (user A sending messages to both remote users when a remote user is to be placed on hold, i.e., disconnecting transmitter per Fig. 2-1).

 Regarding claim 25, Q.734 discloses a computer readable medium operable to execute the following on a processor for interworking protocols to provide a conference feature in a communication network (conference bridge at local exchange per sec. 1.2.1), comprising:

placing on hold an established data channel between a first subscriber and a second subscriber when adding a third subscriber to the conference or isolating the third subscriber from the conference, (sec. 2.2.1, Fig. 2-1)

wherein a first protocol controls the first subscriber, (A-B interface per Fig.

2-1) and

wherein a second protocol controls the second subscriber; (A-C interface

per Fig. 2-1)

receiving a notification of a call progress for the conference feature in

accordance to the first protocol; (Fig. 2-1) and

mapping the notification into a message in accordance to the second protocol;

(Fig. 2-1) and

sending the second message to the first subscriber. (Fig. 2-1)

Q.734 does not explicitly disclose deactivating a transmitter for an established

data channel. However, Q.734 discloses placing an established data channel on hold

(placing call A-B on hold per Fig. 2-1). Sinnreich from the same or similar fields of

endeavor discloses placing a call on hold by causing the recipient to stop sending

media packets (page 139, para. Call Hold). Thus it would have been obvious to the

person of ordinary skill in the art at the time of the invention to place the call on hold as

per Q.734 by deactivating a transmitter for the second subscriber, i.e., instructing held

party to stop sending media packets as suggested by Sinnreich. The motivation for

doing so would have been to avoid sending data that will not be used when the call is

on hold.

Note: The phrase "operable to" recited in claim 25, line 1, is not a positively

recited claim limitation. Therefore, the limitations after the phrase are not considered

the claim limitation. It is suggested that the applicant remove the phrase. However, the

references cited teach the subject matter following the phrase.

8.   Claims 19-21 are rejected under U.S.C. 103(a) as being unpatentable over

Sinnreich, et al, in view of ITU-T Q.734, and further in view of 3GPP TS 29.163 v.1.8.0

(2003-08) (Interworking between the IM CN subsystem and CS networks (Release 6),

hereinafter 3GPP).

      Regarding claim 19, Sinnreich discloses a media gateway controller for an

interworking of protocols for a conference feature within a communication network,

comprising

      an ISUP protocol message for controlling a first subscriber; (ISUP and telephone

per Fig. 9.1)

      a SIP protocol message for controlling a second subscriber; (SIP and SIP phone

per Fig. 9.1)

      a protocol converter from the ISUP protocol message to the SIP protocol

message, (Gateway with ISUP and SIP interfaces per Fig. 9.1) and

      Sinnreich does not explicitly disclose:

      a status of a transmitter for the second subscriber;

      wherein the status is active or deactive.

      However Sinnreich discloses controlling the second subscriber to determine if it

is active or held (page 139, para. Call Hold). It is obvious to one of ordinary skill in the

art at the time of the invention that status of the transmitter determines whether the call

is on hold, i.e., data not being transmitted. Thus it would have been obvious to the

person of ordinary skill in the art at the time of the invention to maintain the status of

transmitter of the second subscriber in order to control the call.

Sinnreich discloses all of the subject matter except wherein when the ISUP

protocol message is a call progress notification with "Conference established" or

"Conference disconnected" and the status is disconnected, the SIP protocol message

created by the converter indicates to activate the transmitter. 3GPP from the same or

similar fields of endeavor discloses mapping between the ISUP Call Progress message

and SIP INVITE message to hold or resume a call. (sec. 7.4.10, 9.2.9) It is obvious to

one of ordinary skill in the art at the time of the invention to resume a call by activate the

transmitter thereby causing data to be transmitted. Further, 3GPP discloses

interworking between ISUP and SIP to support conference calling in Q.734.1. (sec.

7.4.14) It is obvious to one of ordinary skill in the art at the time of the invention that

Q.734.1 discloses "Conference established" and "Conference disconnected" as values

for Generic notification indicator parameter in the ISUP Call Progress message (Table

1-1; sec. 1.5.2.1.1.2), and that invocation of conference calling includes placing a

remote party on hold (sec. 2.2.1). Thus it would have been obvious to the person of

ordinary skill in the art at the time of the invention to combine sending of a SIP message

to instruct a remote user to activate the transmitter to join the conference corresponding

with the ISUP Call Progress message with "Conference established" indication as

suggested by 3GPP with the ISUP/SIP network of Sinnreich. The motivation for doing

so would have been to enable support of conference calling between ISUP and SIP
networks.

      Regarding claim 20, 3GPP further discloses

      wherein the SIP message is an INVITE and includes an activate attribute of
"a=sendrecv" or "recvonly" or

      wherein the SIP message is an UPDATE and includes an activate attribute of
"a=sendrecv" or "recvonly". (sec. 7.4.10)

      Regarding claim 21, Sinnreich does not explicty disclose wherein when the
ISUP protocol message is a call progress notification with "Isolated" the SIP protocol
message created by the converter includes a deactivate attribute of "a=sendonly" or
"a=inactive". However it is obvious to one of ordinary skill in the art at the time of the
invention to isolate a user from the conference by stopping transmission with the user,
and SIP attribute "a=inactive" marks a connection with no transmission. Further Q.734
discloses the ISUP protocol message call progress notification with "Isolated" to isolate
a conferee from the conference (sec. 1.5.2.1.1.3). Thus it would have been obvious to
the person of ordinary skill in the art at the time of the invention to map SIP attribute
a="inactive" with ISUP call progress with "Isolated" indication in order to remove the
user from the conference.

<div align="center">

Allowable Subject Matter

</div>

9.   Claims 15-18, 22-24 and 26-27 are objected to as being dependent upon a
rejected base claim, but would be allowable if rewritten in independent form including all
of the limitations of the base claim and any intervening claims.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form 892).

11.   Examiner's Note: Examiner has cited particular paragraphs, columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and, also to verify and ascertain the metes and bounds of the Claimed invention.

12.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luat Phung whose telephone number is 571-270-3126. The examiner can normally be reached on M-Th 7:30 AM - 5:00 PM, F 7:30 AM - 4:00 PM.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. P./

Examiner, Art Unit 2616

/Huy D. Vu/

Supervisory Patent Examiner, Art Unit 2616